

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 18, 2007. At the time of the Office Action, Claims 25-34 were pending in this Application and were rejected. Applicant respectfully requests reconsideration and favorable action in this case.

### Affidavit under 37 CFR §1.131

The Examiner indicated that the affidavit filed under 37 CFR 1.131 on August 6, 2007, was ineffective to overcome the Mazzuca reference. Applicant respectfully traverses. According to the MPEP, a Rule 131 affidavit provides three ways in which an applicant can establish prior invention of the claimed subject matter. See MPEP, § 715.07. One way in which an applicant can establish prior invention is with a showing of facts sufficient to indicate “conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction of practice).” See Id. Further, “[u]nder 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or construction (i.e., filing a United States patent application).” See Id. at § 715.07(a).

In the Rule 131 affidavit and accompanying exhibits filed on August 6, 2007, Applicant respectfully submits that it provides a showing of facts that the subject matter of the claimed invention was conceived in the United States at least by December 4, 2001, a date prior to the effective date of the cited reference. See Affidavit, ¶ 6; see also Exhibit C, Invention Disclosure Form, p. 2, ¶ 6 (stating the invention was first conceived in Scotts Valley, California). Additionally, the Rule 131 affidavit shows that the claimed subject matter was constructively reduced to practice on November 25, 2003 with the filing of a non-provisional application in the United States. See Affidavit, ¶ 2. Applicant relies on the filing of that United States patent application by its attorney in order to establish the date for its constructive reduction to practice of the claimed subject matter. In order for such constructive reduction to practice of the claimed invention to inure the benefit of a prior conception date to the inventor, reasonable diligence of

an attorney in filing a patent application disclosing the claimed invention during the critical period is all that is required. Furthermore, reasonable diligence is established if the attorney worked reasonably hard on the application during the critical period. See *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986).

Applicant submits that the critical period in which Applicant was required to show reasonable diligence in order to establish prior invention was from just prior to the effective date of the cited reference until the date of Applicant's constructive reduction to practice. As such, Applicant is required to show reasonable diligence from just prior to September 26, 2003 until November 25, 2003, a period of approximately two months. Applicant submits that the approximately two-month period between the time just prior to the effective date of the reference and the filing date of the application including the claimed subject matter is a reasonable time period for Applicant's attorney to have prepared and filed such an application. Reasonable diligence by an attorney during the critical period in preparing and filing a patent application is all that is required, and taking approximately two months to accomplish such a task is a showing of more than reasonable diligence. Applicant submits that the affidavit filed on August 6, 2007 under 37 CFR 1.131, establishing a conception date prior to the effective date of the reference and reasonable diligence from a time just prior to the date of the reference up to the filing date of the present application, is sufficient to antedate and overcome the Mazzuca reference. Therefore, Applicant respectfully submits that claims 25-34 are in condition for allowance, and requests that the rejection be withdrawn.

**Information Disclosure Statement**

Applicant encloses an Information Disclosure Statement and PTO Form 1449 for the Examiner's review and consideration.

### CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS to Deposit Account No. 50-0359 of ArthroCare Corporation.

Applicant believes there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicant,



Matthew Scheele  
Reg. No. 59,847

Date: 1/16/08

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Enclosure:    1)    6 Pages of Replacement Sheets of Drawings.  
                    2)    Information Disclosure Statement and PTO Form 1449.